

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Breen, John J. et al §
Serial No. 10/688,546 § Confirmation No.: 1162
Filed: October 17, 2003 § Group Art Unit: 2116
For: INFORMATION HANDLING SYSTEM §
INCLUDING FAST ACTING §
CURRENT MONITORING AND §
THROTTLING CAPABILITY § Examiner: Yanchus III, Paul B.

REPLY BRIEF IN RESPONSE TO 37 CFR § 41.41

Mail Stop Appeal Briefs – Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Paper is submitted pursuant to 37 CFR §41.41 as a Reply Brief to the Examiner's Answer, mailed on March 17, 2008.

1. *Background and Introduction*

The rejections in this application are based on two references: (1) Applicant's Admitted Prior Art (AAPA hereinafter), in view of Atkinson (U.S. Patent No. 6,498,460) (Atkinson hereinafter). In the "Response to Argument" section (section 10) beginning on page 13 of the Examiner's Answer, the Examiner characterizes the Appellants arguments as follows:

- a) The combination of the references do not teach or suggest all of the elements of the pending claims
- b) The references teach away from the pending claims

The Examiner provides counter-arguments in response to each of the above-noted arguments, which are addressed below in section 3 of this Reply Brief.

2. *Legal Precedent*

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach the invention as a whole.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ... [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In combining multiple references for a 103 rejection, the Supreme Court has ruled that the "teaching, suggestion, or motivation (TSM) test" still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739. The Court stated that "a patent composed of several elements is **not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art**. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a **reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does**. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." Id. at 1741, emphasis added.

Thus, in the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

3. *Appellant's Reply to Examiner's Answers*

This section addresses each of the Examiner's answers, or counter-arguments, set forth in section 10 of the Examiner's Answer.

- a) The combination of the references do not teach or suggest all of the elements of the pending claims

With regard to the limitation “continuously monitoring, in real time by hardware components, the output current of the battery if the battery is supplying power to the IHS”, Appellants maintain their position that the references fail to disclose all of the recited elements as defined in the specification and figures of the pending application. Again, the Examiner has conceded that AAPA fails to disclose continuous current monitoring in real time by hardware components. Again, the Examiner has conceded that Atkinson fails to disclose monitoring output current of a battery. In addition, Atkinson fails to disclose “continuously” monitoring the current. As shown at least in column 7, lines 55 – 59, a “time delay on the battery charger side causes the battery charger to wait for a predetermined period of time to elapse after which the comparator’s [108 of Fig. 1] output is again checked by the battery charger 114 to determine if the power budget problem has subsided.” Similarly, column 8, lines 20 – 23 recite that a “similar time delay as discussed above is included in the throttle logic 130 to cause a delayed reassessment of the power budget condition of the system.” Thus, it is obvious that Atkinson is not “continuously monitoring, in real time by hardware components, the output current of the battery if the battery is supplying power to the IHS”.

Therefore, for all of the reasons previously set forth and set forth herein, it is clear that, contrary to the Examiner’s assertions, the combination of the references fail to teach or suggest all of the claim elements.

b) The references teach away from the pending claims

The Applicant’s prior argument of paragraph [0005] teaching away from the pending claims is disputed by the Examiner by stating on page 14 of the Examiner’s Answer that “[n]owhere in the specification does the AAPA teach or suggest that the claimed method of monitoring current (continuously and in real time by hardware components) cannot be accomplished or is not preferred over the prior art method of monitoring current. This is respectfully traversed. As previously argued, paragraph [0005] states, in part,

[u]nfortunately, the BIOS software monitors the adapter and battery current non-continuously, namely at a relatively low rate, for example 10 - 20 times per second. If the power adapter current or battery current exhibits rapid changes or pulses, it is possible that the relatively slow acting BIOS software may not detect these rapid changes and pulses. Should this occur, the adapter and battery may be driven beyond their intended capabilities and thus experience excessive current draw and heating. This may result in battery and/or AC-DC latch-off and data loss.

Thus, this section of the AAPA is criticizing, discrediting, and discouraging the solution claimed in the pending claims. As such, the AAPA is teaching away from the claims. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Thus, a combination of AAPA and Atkinson is improper.

Therefore, for all of the reasons previously set forth and set forth herein, it is clear that, contrary to the Examiner's assertions, the references teach away from the claims and cannot be combined to reject the pending claims.

4. Conclusion

In view of the foregoing, it is respectfully submitted that the various combinations of references fail to teach or suggest the subject matter of claims 1-23. For all of the foregoing reasons, it is respectfully submitted that claims 1-23 be allowed and a prompt notice to that effect is earnestly solicited.

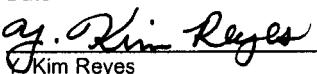
Respectfully submitted,


Bart A. Fisher
Registration No. 55,181

Dated: 5-15-2008
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8458
Facsimile: 214/200-0853
ipdocketing@haynesboone.com

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office, via EFS-Web, on the date indicated below:

on May 15, 2008
Date

✓Kim Reyes